

REMARKS/ARGUMENTS

Original claims 1-19 remain in the application.

Claims 1-3, 6, 7 and 14 have been rejected.

Claims 10-13 and 15-19 have been allowed.

Claims 4, 5, 8 and 9 are objected to.

The Examiner has objected to the drawings under 7 CFR 1.84(p)(4) because reference number “50” has been used to designate both “the aperture” and “the load terminal cover”. The drawings are correct as originally submitted. However, there was an inadvertent error with respect to reference numerals 46 and 50 in paragraph 0006, which has been corrected by amendment in this paper.

The disclosure has been objected to for informalities that were not specifically identified by the Examiner. However, applicants believe the Examiner is referring to the summary and background, which were omitted from the application.

37 CFR 1.73 states “Such summary should, when set forth, be commensurate with the invention...”. The verb “should” does not imply an absolute requirement, but does suggested an optional requirement, particularly when followed by the phrase “when set forth”, which indicates that the subject of the verb “should”, in this case "summary", may not be present. Therefore, 37 CFR 1.73 does not require a summary. 37 CFR 1.77(a) specifically states “The elements of the application, if applicable, should appear in the following order:” and continues with a list of six (6) elements. Element 5 is “drawings”. Many applications, by their nature, do not require a drawing for understanding and it is therefore not required. Therefore, the words “if applicable” and “should”, in 37 CFR 1.77(a), indicate that the list of six (6) elements is merely a suggestion of elements that could be included in the application, not list of required elements. 37 CFR 1.77(b) further defines the specification, element four (4) from the list, and specifically states “The specification should include the following sections in order:” and continues with a list of eleven (11) sections. Element 4 is "Reference to a 'Sequence Listing', a table, or a

computer program listing appendix submitted on a compact disc and an incorporation by reference of the material on the compact disc". Again, many, if not most, applications do not require a "Sequence Listing", a table or a computer program listing. Therefore, the list of sections in 37 CFR 1.77(b) is merely a suggestion of sections that can be included in the specification, not a list of sections that are required. 37 CFR 1.77(c) provides further support that the list of sections in 37 CFR 1.77(b) is merely a suggested list by stating, "The text of the specification sections defined in paragraphs (b)(1) through (b)(11) of this section, if applicable, should be preceded by a section heading in uppercase and without underlining or bold type." Further, 35 U.S.C. 112, as last amended, specifically states, "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. [New paragraph in original.] The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

Applicants contend that according to the texts of 35 U.S.C. 112, 37 CFR 1.73, 37 CFR 1.77(a), 37 CFR 1.77(b) and 37 CFR 1.77(c), there is no specific requirement, stated or suggested, that a patent specification must include a background of the invention or a summary of the invention. The undersigned Applicants' attorney will provide the Examiner with patent numbers of several recently issued U.S. patents, which do not contain a "Background of the Invention" and/or a "Summary of the Invention" section, if so requested.

Claims 3, 6 and 14 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 3, 6 and 14, have each been amended to replace the indefinite term "can be" with "is" or "are" and are deemed to be in condition for allowance.

Claims 1, 2 and 7 have been rejected under 35 U.S.C. 103 (a), as being unpatentable over Green et al. (US 6,144,001) in view of DeGrazia et al. (US 6,356,175). According to M.P.E.P. 706.02(j), three basic criteria must be met for a *prima facie* obviousness rejection of claims under 35 U.S.C. §103(a). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. Further, M.P.E.P 2143.03 states "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."

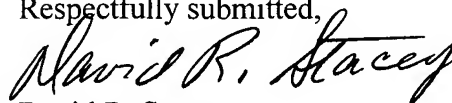
With respect to independent claim 1, applicants agree Green discloses elements of the circuit breaker as set forth in claim 1. However, the terminal cover as defined in claim 1 includes elements not addressed in the Examiner's rejection of claim 1. Applicants contend that these elements define over both Green and DeGrazia individually and in combination. Specifically claim 1 defines the terminal cover as having an end wall "being dimensioned to cover said circuit breaker end wall, a top flange and a bottom flange being generally perpendicular to and spaced apart by said end wall, said top and bottom flanges each defining at least one means for attaching said terminal cover to said molded case circuit breaker." The Examiner's rejection merely states "the terminal cover end wall 50, being flat and dimensioned to cover the circuit breaker end wall". Neither Green nor DeGrazia teach or suggest a terminal cover having "a top flange and a bottom flange being generally perpendicular to and spaced apart by said end wall, said top and bottom flanges each defining at least one means for attaching said terminal cover to said molded case circuit breaker." Both Green and DeGrazia teach a terminal cover that must

be installed on the circuit breaker by sliding down the face of the circuit breaker end wall. Green describes this installation procedure in column 9, lines 31-60, and DeGrazia describes the procedure illustrated in Figure 51 in column 24, lines 50-54. Top and bottom flanges generally perpendicular to and spaced apart by the terminal cover end wall, and each defining at least one means for attaching the terminal cover to the molded case circuit breaker would be impossible to install in the manner taught by both Green and DeGrazia. Therefore, the Examiner's suggested combination of Green and DeGrazia does not teach or suggest all of the limitations of claim 1 or meet any of the three requirements for an obviousness rejection under 35 U.S.C. 103 as set forth in M.P.E.P. 706.02(j). Therefore, claim 1 as filed is clearly patentable over the cited art.

Claims 2 and 7 are dependent from claim 1, and, according to M.P.E.P. 2143.03, "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)." Therefore, dependent claim 2 also is clearly patentable over the cited art.

In reply to the Office Action dated April 15, 2005, the objections and rejections set forth by the Examiner have been carefully considered. Amendments have been made to the specification and claims 3, 6 and 14 to overcome the Examiner's objections and 35 U.S.C. 112, second paragraph, rejections. Arguments have been presented herein to overcome the Examiner's 35 U.S.C. 103 rejections. Applicants believe all pending claims are in condition for allowance and respectfully request a favorable reconsideration and allowance of this Application.

Respectfully submitted,



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